REMARKS

This amendment is responsive to the final Office Action[1] dated April 4, 2005. ,

Preliminarily, the specification is hereby amended to correct a typographical error. No new matter is added. Support for this amendment is shown at least in Fig. 7, steps 710 and 720, where RAM is random access memory and ROM is read only memory.

Claims 1-2, 4-5, 7-8, 10-11, 13-20, 25 and 27-37 were presented for examination. Independent claims 1, 7, 13, 14, 17, 20, 25, 27, and 30 are all currently amended. Support for these amendments is found in the application as filed. For example, *see* at least page 12, lines 3-6 and the Figures, especially Fig. 7. No new matter is added by way of these amendments.

More specifically claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, and 27-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Patent Number 6,275,490 to Mattaway et al. (hereinafter "MATTAWAY") in view of Patent Number 6,078,582 to CURRY et al. (hereinafter "CURRY"). Claims 14-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over MATTAWAY in view of CURRY in further view of Wiener et al., U.S. Patent Number 6,324,264 (hereinafter WIENER). Applicant respectfully traverses the rejection of these claims for the following reasons.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, and 27-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MATTAWAY in view CURRY. These claims are not disclosed or

[1] The Office Action may contain a number of statements characterizing the cited reference(s) and/or the claims which Applicant(s) may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant(s) does not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicant(s) deems allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicant(s) that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

suggested by this combination of references. For example, consider amended independent claim 1 which recites a combination of features.

> A method of making a telephone call using a computer having a user interface, the computer operating upon an electronic document, comprising: receiving an electronic document that includes data representing at least one telephone number; selecting by way of the user interface a telephone number from a location in the electronic document to obtain a selected telephone number; retrieving data, associated with the location, from the electronic document, wherein the data comprises the telephone number in a format usable for setting up a call; determining if a calling party telephone number had been previously stored in local memory in the computer; prompting a user to enter the calling party telephone number into the computer if the calling party telephone number had not been previously stored in the local memory in the computer, thereby storing the calling party telephone number in the local memory within the computer to obtain a locally stored calling party telephone number; signaling, via a packet-switched network, a telecommunication system to connect a call between the selected telephone number and the calling party telephone number using the retrieved data; and using the locally stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number. (Emphasis added.)

The final Office Action, page 3, states deficiencies in MATTAWAY with respect to certain independent claims including claim 1, namely: "Mattaway does not expressly disclose receiving a calling party telephone number; storing the calling party telephone number in local memory within the computer to obtain a locally stored calling party telephone number; and using the stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number." Applicant agrees[2].

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[2] The final Office Action then continues with MATTAWAY's alleged manipulation of a calling party address, but this is an irrelevant argument because an address is not a telephone number. Furthermore, the instant claim amendments clearly avoid the combination of MATTAWAY and CURRY in any event, as explained herein.

The final Office Action relies on CURRY to make up for these deficiencies of MATTAWAY, but CURRY still falls short. Reviewing the Examiner's position on CURRY, in the prior office action dated December 2, 2004, the Examiner alleged that CURRY disclosed storing the calling party's telephone number in the ITS server (prior Office Action, page 3, lines 15-16) which is positioned in the network on the remote side of the Central Office from which the calling party (user) is connected. Any storage in that server is therefore not storage in "local" memory (i.e., local with respect to the calling party) as claimed. (*See*, e.g., Fig. 6, CURRY, calling party 64c, central office CO 41 and ITS(C) server 72c). Applicant responded in its amendment filed on March 7, 2005 by amending its claims to, *inter alia*, storing the calling party telephone number in local memory in the computer which clearly avoided the alleged storing of the calling party number in CURRY's remote ITS server.

However, in an attempt to continue to apply CURRY against Applicant's amended claims, the instant final Office Action now alleges that "storage" takes place in the calling party's telephone, which is stated to be needed for a call to be placed:

> "Curry teaches, in a telecommunications system, storing the calling party telephone number in [local] memory within the computer proximate the user interface to obtain a [locally] stored calling party telephone number (col. 5, lines 12-15) where it is implicit that a phone ***needs*** to store its own telephone number in order to formulate a call request containing its own telephone number; and using the stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number (col. 5, lines 12-15) where it is implicit that this is done in order to allow a phone to set-up a call using a telephone network (col. 5, lines 12-15)." (final Office Action, pages 3-4, Emphasis added.)

Thus, according to this final Office Action statement, a calling party's telephone needs to store its own telephone number in order to formulate a call. In support of this position, the Examiner cites in the foregoing statement a portion of CURRY, which relates to the subject of telecommunication over the Internet, and which states:

> "A call request initiated by a calling party within the first telephone network, is received at the first telephony server. The call request includes a calling party number corresponding to the calling party and a called party number, the called party number including an area code." (CURRY, column 5, lines 12-15)

Notably, there is no express indication of any "storage" of the calling party's telephone number in the above-quoted passage, much less an indication of storage in a local memory within a computer having a user interface as claimed. This passage merely says that a call request is received at the first telephony server and that the call request includes a calling party number. It doesn't mention storage of the calling party's telephone number at the location of the origination of the call. To the extent there may be an implication of storage of the calling party's telephone number in its telephone, such implication may be countered, if not overcome, by a stronger, contrary implication in a more detailed passage in CURRY relating to the same subject of Internet Long Distance Call Processing. This contrary passage appears to point away from a position of local telephone storage of the calling party's telephone number.

In CURRY, column 14, line 61 through column 15, line 28, it says that the caller goes off hook and dials *82 and dials the directory number of the called party including area code and it refers to these as the "dialed digits". CURRY then says that the central office receives the dialed digits (note that a calling party number is not included in the dialed digits) and sends a CCIS query message to the ITS server. In response to the query message the ITS server sends a

routing request including the number of the calling party and the area code of the called party. But, the calling party telephone number was not included in the "dialed digits", which begs the question: where did the calling party's telephone number come from? There may be an implication that the calling party's telephone number was already at either the Central Office or the ITS server. In any case, it is respectfully submitted that there is no suggestion that the calling party's telephone number is "stored" in the calling party's telephone, at least for the reason that it is not included in the dialed digits in this example. Moreover, even if there were an implication of storage of the calling party's telephone number at the calling party's telephone, there is no indication in the above-quoted passage that any such stored calling party's phone number is stored for the purpose of connecting all subsequent calls from the calling party, as claimed. It is respectfully submitted that, for the reasons given above, claim 1 is not disclosed or suggested by CURRY or by the combination of MATTAWAY and CURRY.

Nevertheless, assuming, *arguendo*, that storage of the calling party's telephone number at the calling party's telephone is implied, as the final Office Action alleges, Applicant's currently amended claim 1 completely avoids the Examiner's position with respect to this passage in CURRY because CURRY does not disclose or suggest the determining step/act of claim 1 in the above-quoted passage or elsewhere. Applicant's claim 1 recites, *inter alia*: "determining if a calling party telephone number had been previously stored in local memory in the computer". But, if CURRY has a need for the calling party's telephone number to be stored in order to formulate a call request containing its own telephone number, as alleged in the final Office Action, then that storage is a necessity and therefore a certainty. Therefore, CURRY cannot disclose or suggest this determining step which is used to determine an uncertainty, namely

whether or not a calling party telephone number was previously stored in local memory in the computer. MATTAWAY does not cure this deficiency. It is respectfully submitted that, for this reason alone, claim 1 is not disclosed or suggested by the combination of MATTAWAY and CURRY.

It logically follows that CURRY also cannot disclose or suggest Applicant's prompting step/act of currently amended claim 1: "prompting a user to enter the calling party telephone number into the computer if the calling party telephone number had not been previously stored in the local memory in the computer, thereby storing the calling party telephone number in the local memory within the computer to obtain a locally stored calling party telephone number." Again, if CURRY suggests a need or certainty for a calling party telephone number to be stored in order to complete the call, then it cannot disclose Applicant's "prompting" step/act which is premised on the possibility that the calling party telephone number may not have been previously stored. CURRY cannot disclose or suggest this prompting step/act because the calling party telephone number was previously and necessarily stored in local memory, as a matter of need according to the Examiner's interpretation of the above-quoted passage. MATTAWAY does not cure this deficiency. Therefore, it is respectfully submitted that, again, for this reason alone, claim 1 is not disclosed or suggested by the combination of MATTAWAY and CURRY.

To establish a *prima facie* case of obviousness, all of three basic criteria must be met: first, the prior art references, when combined, must teach or suggest *all* the claim limitations; second there must be a reasonable expectation of success; and finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings (*See* MPEP § 2143). If any one of these criteria is not met the *prima facie* case of obviousness is not established. In this instance, the prior art references, when combined, do not teach or suggest all of the claim limitations.

In view of the above, a *prima facie* case of obviousness under MPEP § 2143 has not been established against claim 1, at least because all of the claim elements of claim 1 have not been disclosed or suggested by the combination of MATTAWAY and CURRY. Furthermore, WIENER does not cure the deficiencies of MATTAWAY or CURRY. For example, at least "determining if a calling party telephone number had been previously stored in local memory in the computer" as recited in currently amended claim 1 is not disclosed or suggested by CURRY, where MATTAWAY and/or WIENER do not cure this deficiency. For another example, at least "prompting a user to enter the calling party telephone number into the computer if the calling party telephone number had not been previously stored in the local memory in the computer, thereby storing the calling party telephone number in the local memory within the computer to obtain a locally stored calling party telephone number" as recited in currently amended claim 1 is not disclosed or suggested by CURRY, where MATTAWAY and/or WIENER do not cure this deficiency either.

The other two requirements for establishing a *prima facie* case of obviousness are moot, and shall not be considered in view of the failure of the references to show all claim elements. It is therefore submitted that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

Independent claims 7, 13, 25, 27, and 30, also rejected over MATTAWAY in view of CURRY, have been similarly amended. Therefore, it is submitted that these claims are allowable for reasons similar to those given above.

Each one of dependent claims 2, 4, 5, 8, 10, 11, 15, 16, 18, 19, 28, 29, and 31-37 is dependent, directly or indirectly, from one of these allowable independent claims, and is therefore submitted to be allowable for reasons based on, at least, its respective dependency from an allowable base claim.

Claims 14-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over MATTAWAY in view of CURRY in further view of WIENER. As previously noted in the record, WIENER does not cure the various Examiner-admitted deficiencies in MATTAWAY and as noted hereinabove does not cure the deficiencies of CURRY expressed in this instant response. For example, the calling party's telephone number is stored in WIENER in a remotely located database accessible through the Internet and not locally, in a computer having a user interface (e.g., a personal computer). Thus, at least "....storing the calling party telephone number in the *local* memory within the *computer* to obtain a locally stored calling party telephone number", as recited in claim 1, is not disclosed or suggested by WIENER, because WIENER stores the calling party telephone number remotely from the user in a database that doesn't have a user interface. Applicant shows computer 105 with computer terminal screen user interface in its Fig. 1 and shows computer 105 as containing input device 210 in its Fig. 2. Input device 210 is described in Applicant's specification on page 7, lines 19-20 as containing one or more user interfaces. In the computer shown in Applicant's Fig. 2, ROM 225 and/or RAM 220 are the location (the *local* memory within the computer *having a user interface*) in

which the calling party's phone number may be stored. *See* Applicant's specification, page 12, lines 6-7, for example. Applicant submits that WIENER's remote directory, by contrast, which is accessible only via an Internet link and which stores the calling party's telephone number is not equivalent to a computer having a user interface which locally stores the calling party's telephone number. Applicant therefore submits that WIENER teaches away from Applicant's subject matter as recited in the currently amended claims and, for at least this reason, does not cure the deficiencies of MATTAWAY or CURRY. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claims 14-20 be withdrawn and the claims allowed for the reasons given above.

Summarizing:

The Examiner's position in the December 7, 2004 Office Action was that the calling party's telephone number is stored in CURRY's remotely located ITS server, where that stored telephone number can be used for making subsequent calls. But, that storage location is not local to the calling party and the currently amended claims requiring local memory define around that view of CURRY.

By contrast, now the Examiner's position in the instant final Office Action is that the calling party's telephone number is (1) locally stored in the calling party's telephone where it needs to be stored in order that the telephone can formulate a call request containing its own telephone number and is (2) used for making subsequent calls. But, this current position postulates a certainty of storing the calling party's telephone number in the calling party's telephone, also defined-around by the currently amended claims.

Thus, regardless of which of these two positions is maintained by the Examiner at any given time, the currently amended claims define around both the previous position and the current position, even if both positions are asserted simultaneously, (i.e., even if the Examiner asserts that the calling party's telephone number is stored both in the calling party telephone AND in the ITS server).

CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are urged to be allowable over the cited references. Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

Applicant has reviewed Narain, U.S. Patent 5,535,506 (hereinafter, "NARAIN") which was made of record as being pertinent to Applicant's disclosure, but not relied upon. Applicant agrees that it should not have been relied upon. NARAIN does not cure deficiencies of the prior art being relied upon.

It is submitted that these amendments do not raise new issues nor do they require the Examiner to do further searching. It is respectfully requested that this amendment be entered, at least for narrowing down issues which may be presented on appeal if the Examiner does not find this response to be persuasive. If any questions remain, the Examiner is invited to contact the undersigned at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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